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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,028	12/29/2000	Kristin Carman	06975-139001/Packaging 01	6435
26171	7590	12/07/2004	EXAMINER	
FISH & RICHARDSON P.C. 1425 K STREET, N.W. 11TH FLOOR WASHINGTON, DC 20005-3500			RETTA, YEHDEGA	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/750,028

Applicant(s)

CARMAN ET AL.

Examiner

Yehdega Retta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This office action is responsive to amendment filed September 8, 2004. Claims 1 and 29 have been amended.

Requirements for Information

37 CFR 1.105 states: (a) (1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

- (I) Commercial databases: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.
- (ii) Search: Whether a search of the prior art was made, and if so, what was searched.
- (iii) Related information: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.
- (iv) Information used to draft application: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.
- (v) Information used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention

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process, such as by designing around or providing a solution to accomplish an invention result.

- (vi) Improvements: Where the claimed invention is an improvement, identification of what is being improved. (vii) In Use: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.
- (2) Where an assignee has asserted its right to prosecute pursuant to' 3.71 (a) of this chapter, matters such as paragraphs (a)(1)(I), (iii), and (vii) of this section may also be applied to such assignee.
- (3) Any reply that states that the information required to be submitted is unknown and/or is not readily available to the party or parties from which it was requested will be accepted as a complete reply.
- (b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.
- (c) A reply, or a failure to reply, to a requirement for information under this section will be governed by 1.135 and 1.136.

The Office is requiring submission of information reasonably necessary to properly examine and treat the claimed subject matter under Rule 105. Of particular interest is information used in drafting the present operation including information related to the field of endeavor or business practices used by applicant's professional business ventures, to show the information used in the invention process, where the claimed invention is an improvement, identification of what is being improved and identification of any use of the claimed invention

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known to any of the inventors at the time the application was filed notwithstanding the date of the use. Since the application is filed as a large entity status with AOL as assignee, along with the fact that the inventor has more than one pending applications related to the claimed invention and an IDS was submitted, it appears that it would be appropriate to require the applicants to provide information necessary to ensure a quality examination to be performed by the Office.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-49 are rejected under 35 U.S.C. 102(a) as being anticipated by AOL's CD package as indicated in the article AOL Virtual Museum, www.brainblips.com/aol/aol5.0.html and AOL Virtual Museum, www.brainblips.com/aol/aol_canda.html (hereinafter AOL).

Regarding claims 1-49, AOL have been using CD case with first side and second side; first side and second side connected as to permit one side to move relative to the second side; first side structured and arranged to define a viewing window; the viewing window constitutes less than all of the first side to provide a first viewing characteristic that differ from a second viewing characteristic, ... viewing window exposing a portion of the CD; label with information printed on both sides affixed to the side, ... translucent or transparent material to affect the viewing characteristics, ..., etc.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-23 and 29-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flores Jr. 6,454,090 and further in view of AOL.

Regarding claims 1, 3-9 and 22-23, Flores teaches a case comprising of a first side and second side connected as to permit one side to move relative to the second side; first side structured and arranged to define a viewing window; label with information printed on both sides affixed to the side, ... translucent or transparent material to affect the viewing characteristics, ... (see fig. 2 & 6, col. 4 lines 27-57 and col. 6 line 53 to col. 7 line 39). Flores does not specifically teach wherein the viewing window provides a first viewing characteristic that differs from a second viewing characteristic through another portion of the first side the window exposing portion of the surface of the disk. AOL teaches different viewing windows of different size and shape, covering part of the CD It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to modify Flores's disk case with AOL's marketing design. One would be motivated to provide attractive package by using different marketing design in order to make the package attractive to customers. AOL is also known to package the case and mail it to intended recipients.

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Regarding claim 2, Flores teaches a case comprising of a hole (see fig. 2 and col. 4 lines 28-41).

Regarding claims 10-16, Flores teaches first side and second side form a closed cavity and the viewing window enabling perception of the closed cavity (see fig. 2 & 6 and col. 6 line 53 to col. 7 line 16); a disk securing member located with the closed cavity (see fig. 2); an inner surface member (see fig. 1); dimension of the case being greater than Jewel case (see col. 4 lines 5-62); compact disk within the case (see col. 9 line 43 to col. 10 line 67);

Regarding claims 17 and 18, Flores teaches compact disk storing electronic marketing materials comprising computer software (see background and col. 1 lines 27-43).

Regarding claims 19-21, Flores teaches a disk protecting member position around the perimeter to the compact disk (see fig. 2 and 6).

Claims 29, 31-34 and 43-44 are rejected as stated above in claims 1, 3-6 and 22-23 respectively.

Claim 30 is rejected as stated above in claim 2.

Claims 35-40 are rejected as stated above in claim 10-16.

Claim 41 is rejected as stated above in claim 18.

Claim 42 is rejected as stated above in claim 20.

Regarding claims 24-28 and 45-49, Flores teaches marketing information printed on the label affixed to the case, however does not teach first side of a label containing information identifying intended recipient. AOL has been known to use a postal package, transparent, with a cut-out window for mailing a disk wherein the front being marked to which the address and postage stamp art to be affixed. It would have been obvious to one of ordinary skill in the art at

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the time of the applicant's invention was made to modify Flores case by implementing AOL's packaging system by printing recipients address and affixing a postage stamp for the purpose of mailing the package to recipient. AOL is also known to provide a wrapper around a case. It would have been obvious to one of ordinary skill in the art at the time of the invention to wrap a case before shipping it to recipient. One would be motivated to wrap the case before mailing it, in order to protect the disk from being used before reaching the intended recipient. No patentable weight is given to the claimed limitation of position the disk outside the case since what is claimed does not change the structure of the claimed device.

Response to Arguments

Applicant's arguments filed September 8, 2004, with respect to the rejection(s) of claim(s) 29-49 under 35 U.S.C 101 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. The rejection regarding Double Patenting has been withdrawn since applicant filed a terminal disclaimer.

Applicant's arguments with respect to claims 1-49 have been considered but are moot in view of the new ground(s) of rejection. However, it must be recognized that matters relating to ornamentation only, and having no mechanical function, cannot be relied on where claims are not directed to design but are structural claims. *In re Seid*, 73 USPQ 431, 433 (CCPA 1947). Such limitation related to where and how the viewing window is positioned and which part of disk or how the disk is exposed has no mechanical function.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Yehdega Retta".

Yehdega Retta
Primary Examiner
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